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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,228	04/02/2001	Hirofumi Nakayasu	010273	6723
38834	7590	11/22/2004	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP			DIVINE, LUCAS	
1250 CONNECTICUT AVENUE, NW			ART UNIT	
SUITE 700			PAPER NUMBER	
WASHINGTON, DC 20036			2624	

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/822,228	Applicant(s) NAKAYASU ET AL.	
	Examiner Lucas Divine	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Drawings***

1. The drawings are objected to because in Fig. 3 S16 has incorrect spelling for **result** and **user**. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: page 10 line 3 teaches the '**desktop personal computers 1-3, 1-4 having a GPS (Global Positioning System) 10**' while in Fig. 1, only the PDA has GPS 10.

Appropriate correction or clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3 – 6, 10, and 12 – 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Eldridge et al. (US 6421716) hereafter referred to as Eldridge.

Regarding claim 10, Eldridge teaches **a printing system 100 comprising:**

a database for storing printing agent printer sites (directory server 142 includes a database for storing services [including printer sites, wherein col. 9 lines 48-49 teaches multiple printers] for client use, further shown in Figs. 4A and 4B wherein the directory service provides information about available printers; col. 4 lines 29-36); **and**

a server 126 for: receiving a print request (selected with button 702 shown in Fig. 7) **and location information** (Fig. 4A step 408 teaches that location information is appended to client requests by the network gateway, which knows the location of the device from sent device information, for example, GPS location as shown in Fig. 3; col. 2 lines 43-46 also teaches that this physical location identifier is received with print requests) **from a client terminal 118, and retrieving, from said database, the printing agent printer site nearest to the location of said client terminal in accordance with said location information** (location-context information

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causes the directory server 142 to generate a list of available local printer sites as shown in Fig. 4A [creation of list] and Fig. 7 [example of list]),

wherein said server 126 sends said nearest printing agent printer site to said client terminal for display (Fig. 4A step 414, wherein the transaction server [part of server 126] sends list of services including available nearest printers to client 118; displays shown in Figs. 7 and 8), **and thereafter, receives from said client terminal a specified printing agent printer site** (Fig. 41 step 442 shows the user selected service [in this case a printer selection] that is being sent to server 126 from the user after the printer list was displayed for the user), **and sends print information of said print request to a printer 102 of said specified printing agent printer site** (Fig. 4B step 462, wherein request is sent to selected device, e.g. printer and further shown in Figs. 2 and 3).

Regarding claim 12, which depends from claim 10, Eldridge further teaches that **said server receives GPS information from said client terminal** (Fig. 3 shows the client terminal sending GPS location information that is received at server 126; col. 6 lines 52-56).

Regarding claim 13, which depends from claim 10, Eldridge teaches that the **server retrieves the current location** (context-location information; Fig. 4A step 408 or 428 as retrieved by the server 144) **of said client terminal based on said location information, and thereafter, retrieves printing agent printer site nearest to said current location** (retrieves nearest printer site in step 412 or 426 of Fig. 4A, wherein the available services includes nearest printer to current client location; for example, Fig. 9 step 926 shows the identification of the nearest services [including printers] in the room the client is currently located within).

Regarding claim 14, which depends from claim 10, Eldridge further teaches that the **server receives agent printing results from said printer, and sends said agent printing results to said client terminal** (col. 10 lines 35-38, wherein a request status log is kept of the and has been sent to the client via the server for viewing).

Regarding claim 15, which depends from claim 10, Eldridge further teaches that the **server receives a user ID from said client terminal, and sends to said client terminal the printing agent printer site selected in the past by the user indicated by said user ID** (Fig. 4A step 410 generates a list of services based on context information which inherently contains the user ID of the requesting user, the idea of sending a list based on past selections is inherent to the system of Eldridge in that it is an advanced printing system and therefore includes the ability to set a default printer [one that the user has used before]).

Regarding claim 1, the structural elements of apparatus claim 10 perform all of the method steps of method claim 1. Claim 1 is therefore rejected for the same reasons as claim 10.

Regarding claim 3, which depends from claim 1, the structural elements of apparatus claim 12 as it depends from claim 10 perform all of the method steps of method claim 3. Claim 3 is therefore rejected for the same reasons as claim 12.

Regarding claim 4, which depends from claim 1, the structural elements of apparatus claim 13 as it depends from claim 10 perform all of the method steps of method claim 4. Claim 4 is therefore rejected for the same reasons as claim 13.

Regarding claim 5, which depends from claim 1, the structural elements of apparatus claim 14 as it depends from claim 10 perform all of the method steps of method claim 5. Claim 5 is therefore rejected for the same reasons as claim 14.

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Regarding claim 6, which depends from claim 1, the structural elements of apparatus claim 15 as it depends from claim 10 perform all of the method steps of method claim 6. Claim 6 is therefore rejected for the same reasons as claim 15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge in view of Johnstone et al. (US 5898680) hereafter referred to as Johnstone.

Regarding claim 11, which depends from claim 10, Eldridge teaches all of the limitations of parent claim 10 as discussed above.

While Eldridge teaches providing a mobile computing device with information on nearest printers, Eldridge does not specifically teach **map information showing said nearest printing agent printer site based on said location information**.

Johnstone teaches **map information showing said nearest printing agent printer site based on said location information** (Figs. 12A and 12B show map information sent to a mobile computing device based on location of user; col. 1 line 41).

It would have been obvious to one of ordinary skill in the art to add the map information of Johnstone to the printing system of Eldridge. The motivations for doing so would have been to help the user find the selected printer and to select a printer that is easiest for them to get to. For

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example, after seeing a map, the user might notice that although one printer may be a little farther, it is located near to where the user might need to go at a later time, allowing for user planning.

Regarding claim 2, which depends from claim 1, the structural elements of apparatus claim 11 as it depends from claim 10 perform all of the method steps of method claim 2. Claim 2 is therefore rejected for the same reasons as claim 11.

5. Claims 16, 17, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge in view of Kawai et al. (US 6404994) hereafter referred to as Kawai.

Regarding claim 16, which depends from claim 14 as it depends from claim 10, Eldridge teaches all of the limitations of parent claims 10 and 14.

While Eldridge teaches a printing agent service for printing client print jobs, Eldridge does not specifically teach that the **server automatically debits a specified account for a printing fee in accordance with printing results**.

Kawai teaches **server** (copier 18 includes printing server functionality as shown in Fig. 4) **automatically debits a specified account for a printing fee in accordance with printing results** (col. 5 lines 15-20, wherein charging device automatically debits a prepaid card, which is the user account information).

It would have been obvious to one of ordinary skill to add automatic payment to the advanced printing system of Eldridge. The motivations for doing so would have been to allow a user to not have to take the time and effort to pay each time the user uses the system and it

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allows the user to have the user print jobs for others without having to worry about the payment for the other user.

Regarding claim 7, which depends from claims 5 and 1, the structural elements of apparatus claim 16 as it depends from claims 14 and 10 perform all of the method steps of method claim 7. Claim 7 is therefore rejected for the same reasons as claim 16.

Regarding claim 17, which depends from claim 10, Eldridge teaches all of the limitations of claim 10 as discussed above.

Eldridge though does not specifically teach that **the instruction of printing that includes an advertisement to said printer in accordance with an advertisement-included printing specification, and discounting a printing fee in accordance with said agent printing that includes an advertisement.**

Kawai specifically teaches that **the instruction of printing that includes an advertisement to said printer in accordance with an advertisement-included printing specification** (if a user so chooses – step S5 – the system be instructed to perform advertisement-included printing, for example the ads printed in the margins of Figs. 2B and 2C; col. 1 lines 64-65 and col. 5 lines 20-22), **and discounting a printing fee in accordance with said agent printing that includes an advertisement** (if advertising is selected, the advertising company picks up some of the charged costs, thus discounting the price for the user; col. 5 lines 22-28 and col. 6 lines 26-28; also in the bottom of col. 7 and the top of col. 8 wherein the charging table memory computes user and advertiser fees based on a number of factors including using advertising, paper size, paper and printing color etc...).

It would have been obvious to one of ordinary skill in the art to add the advertisement and discounting features of Kawai to the location specific printing system of Eldridge. The advertising printing system is said to work well when the location of the user is known (printing of advertisements for businesses nearby the location for example), which would work well with Eldridge's location specific printing system. Also, Kawai teaches the ability to use the advertising system in a networked environment for control of advertising printing from a remote location, which would work well with the remote location networked system of Eldridge. The further motivations would have been to allow the user to not have to pay as much for a print job and for an advertiser to get their word out at a minimal cost (i.e. the advertiser does not have to pay company people to print and distribute the advertisements). The system would also allow the advertiser to reach more markets than previously, allowing specific advertisements to be chosen by the users age, sex, profession, and so on (Kawai col. 8 lines 16-17).

Regarding claim 8, which depends from claim 1, the structural elements of apparatus claim 17 as it depends from claim 10 perform all of the method steps of method claim 8. Claim 8 is therefore rejected for the same reasons as claim 17.

6. Claims 18 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge in view of Maruta et al. (US 6516157).

Regarding claim 18, which depends from claim 10, Eldridge teaches all of the limitations of parent claim 10 as discussed above.

Eldridge does not specifically teach the **server sending an agent printing fee to the client in accordance with the printing results.**

Maruta specifically teaches **server** (center side data processor; Fig. 21) **sending an agent printing fee (S25) to the client** (user side data processor) **in accordance with the printing results** (printing done at copy machine – printer).

The system of Maruta is very similar to the system of Eldridge in that a client sends a print job to a server, which then forwards it on to a printer, so the server acts as the print management interface. Maruta adds the sending to the client the print fee information.

It would have been obvious to one of ordinary skill in the art to add such print fee information to a client in the system of Eldridge. The motivation for doing so would have been to allow or require users to pay for print jobs in the system of Eldridge.

Regarding claim 9, which depends from claim 1, the structural elements of apparatus claim 18 as it depends from claim 10 perform all of the method steps of method claim 9. Claim 9 is therefore rejected for the same reasons as claim 18.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US-6549625, Rautila et al., 4-15-2003 : teaches a method and system for connecting a mobile terminal to a database including for printing a document at the closest available printer.

US-6334109, Kanevsky et al., 12-25-2001: teaches a distributed personalized advertisement system including advertisement-included printing.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 703-306-3440. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 703-308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lucas Divine
Examiner
Art Unit 2624

ljd



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